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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/125,887	10/05/1998	THIERRY BOON-FALLEUR	EX96002-US	8290

29693 7590 08/27/2002

WILEY, REIN & FIELDING, LLP
ATTN: PATENT ADMINISTRATION
1776 K. STREET N.W.
WASHINGTON, DC 20006

EXAMINER

WEHBE, ANNE MARIE SABRINA

ART UNIT PAPER NUMBER

1632

DATE MAILED: 08/27/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory ActionApplication No.
09/125,887Applicant(s)
Boon-Falleur et al.Examiner
Anne Marie WehbéArt Unit
1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Jul 8, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on Jul 8, 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s):
The rejection of claims 37 and 38 under 35 U.S.C. 112, second paragraph.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____
- Claim(s) objected to: _____
- Claim(s) rejected: 20-50
- Claim(s) withdrawn from consideration: _____
8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

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Attachment to Advisory Action

In regards to the rejections of the claims under 35 U.S.C. 102 and 103, the applicant repeats the argument made in earlier responses that the Zhai et al. reference is not enabling for the claimed compositions and methods. In particular, the applicant argues that the Zhai et al. reference does not include as much information as the instant specification and that the *in vitro* experiments reported by Zhai et al. do not suggest *in vivo* success. The applicant also states that it is confusing how the Zhai et al. abstract can be considered enabling when applicant's specification is not. Please note that claims 20-33 were never rejected under 35 U.S.C. 112, first paragraph, for lack of enablement. Claims 34-40 were rejected based solely on the fact that they encompass *in vivo* methods and therapeutic effects. The previous office actions clearly state that the specification is enabling for *in vitro* methods where the cells expressing the tumor antigen are professional antigen presenting cells. Furthermore, the rejections of record under 35 U.S.C. 102 and 103 clearly state that the applicants methods read on **both** *in vitro* and *in vivo* methods and that the references have been applied as anticipating or rendering obvious the *in vitro* aspects of the invention. The rejections of record do not recite that the Zhai et al. reference teaches *in vivo* methods of preparing cytotoxic T cells. Finally in regards to the use of the term "pharmaceutical" in claims 34-36, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure or composition, and where the body of the claim does not depend on the preamble for completeness but, instead, the process

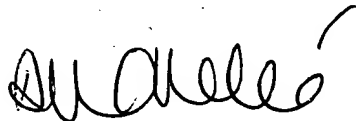
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steps or structural limitations are able to stand alone. *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976); *Kropa v. Robie*, 88 USPQ 478, 481 (CCPA 1951).

In regards to the rejection of the claims under 35 U.S.C. 112, first paragraph, it is noted that the original, amended and new claims continue to recite the use of any type of cell expressing a tumor antigen to stimulate precursor T cells. In addition, applicant's arguments are a repetition of arguments made in earlier responses to the office. These arguments were not deemed persuasive for reasons of record as discussed in detail in papers no. 11 and 16.

Any inquiry concerning this communication from the examiner should be directed to Anne Marie S. Wehbé, Ph.D., whose telephone number is (703) 306-9156. The examiner can be reached Mon-Thurs and every other Friday from 9:30-7:00. If the examiner is not available, the examiner's supervisor, Deborah Reynolds, can be reached at (703) 305-4051. General inquiries should be directed to the group receptionist whose phone number is (703) 308-0196. The technology center fax number is (703) 308-4242, the examiner's direct fax number is (703) 746-7024.

Dr. A.M.S. Wehbé



ANNE M. WEHBE' PH.D
PRIMARY EXAMINER